

REMARKS

In the most recent, non-final office action, dated July 24, 2006 , claims 11-19 were examined. Claims 11-13 and 16-18 stand rejected under 35 U.S.C. § 103(a) as obvious over Sunaga, U.S. Patent No. 6,737,770 in view of Matsuoka, U.S. Patent No. 5,880,666, or vice versa. Claims 14, 15, and 19 stand rejected as obvious under 35 U.S.C. § 103(a) as obvious over Sunaga and Matsuoka and in further view of Lewchenko, U.S. Patent No. 6,058,595. Further, the restriction requirement was made final. By way of this response, the rejection is respectfully traversed, and withdrawal of the rejection and a notice of allowance are respectfully requested.

Claim 11 recites a method of making an electric motor, including connecting an end portion of the first magnet wire directly to the switch, and severing the first magnet wire at the fuse. The Examiner admits that none of the references disclose the noted claim element, but argues that “mere direct connection between [an] end portion of the first magnet wire and the switch is just design choice.” He further argues that “electrically-wise there is no difference between direct and nondirect contacts[,]” and that “applicants fail to disclose any benefit... of having a direct connection.”

The Examiner does not address applicant’s position on patentability where he argues that a motor constructed by the claimed method would function the same as a motor constructed by prior art methods. Claim 11 is directed to a method of manufacture that is faster, more efficient, and less expensive than prior art methods. In other words, an electric motor can be made faster and less expensively by this method as compared to prior art methods with no loss of performance in the motor. Thus, whether the motor ultimately created performs any differently than prior art motors is not the point. See, e.g., the

Background section of the Specification, paragraphs 2 and 3, which describe that prior art methods of manufacture require the separate time-consuming step of attaching a lead wire completely separate from the magnet wire from the fuse to the switch. The claimed invention eliminates this step. Therefore, the claimed method of manufacture is superior to prior art methods because it creates a comparable motor for less money and in less time.

Applicants respectfully traverse the Examiner's taking of official notice that the claimed direct connection would have been obvious, where the Examiner cites no reference that discloses the claimed element. "Official notice without documentary evidence to support an Examiner's conclusion is permissible only in some circumstances [...]. It would not be appropriate for the Examiner to take official notice of facts without citing a prior art reference where the facts asserted to be well known are not capable of instant and unquestionable demonstration as being well-known... It is never appropriate to rely solely on "common knowledge" in the art without evidentiary support in the record, as the principal evidence upon which a rejection was based." MPEP § 2144.03(A) (emphases added). Here, the Examiner relies on no documentary evidence to argue that the noted claim element would have been obvious. The claimed method of manufacture is not capable of instant and unquestionable demonstration as being well-known. Applicants traverse the Examiner's reliance on official notice and submit that the noted element is not common knowledge for the above reasons. The MPEP requires that "the Examiner must provide documentary evidence in the next Office action if the rejection is to be maintained." MPEP § 2144.03(C).

No reference discloses the step of including connecting an end portion of the first magnet wire directly to the switch, and severing the first magnet wire at the fuse. Furthermore, no reference provides any suggestion to construct an electric motor in the

claimed method. Accordingly, claim 11 is allowable over the art of record. Dependent claims 12-19 are allowable for at least the same reasons.

CONCLUSION

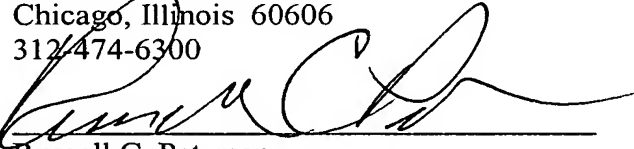
In view of this response, the pending application is in condition for allowance. If, in the opinion of the Examiner, a telephone conference would expedite prosecution of the subject application, the Examiner is invited to call the undersigned attorney.

The Commissioner is hereby authorized to charge any deficiency in the fees filed, asserted to be filed or which should have been filed herewith (or with any paper hereafter filed in this application by this firm) to our Deposit Account No. 13-2855, under Order No. 28076/SV1094/US.

Respectfully submitted,

MARSHALL, GERSTEIN & BORUN LLP
6300 Sears Tower
233 South Wacker Drive
Chicago, Illinois 60606
312-474-6300

By:



Russell C. Petersen
Registration No. 53,457
Attorney for Applicants

October 24, 2006